

REMARKS

Claim 12 has been amended to correct a clerical error, and not for any reason of patentability. Claims 1-26, 28-35, 37 and 38 remain pending in the present application.

Section 121 Restriction:

The Examiner indicates that restriction is required between Inventions I and II as listed on page 2 of the Office Action. In response to this restriction requirement, Applicants elect Invention I **with traverse**. Applicants traverse the restriction requirement on procedural grounds that the Examiner has failed to state a proper restriction requirement.

The Examiner contends that “Inventions I and II are related as subcombinations disclosed as usable together in a single combination.” However, Inventions I and II are *not disclosed* in Applicants’ disclosure as *separate subcombinations* usable together in a single combination. For example, Invention I (as defined by the Examiner) includes a server and a small device. Invention II (as defined by the Examiner) includes a server similar to the server of Invention I. According to the Examiner’s reasoning, Applicants’ disclosure would have to describe the server and small device of Invention I as being used in a single combination with the server of invention II. Although all of the independent claims could read on a multi-server embodiment, the server recited in both claim 1 (Invention I) and claim 12 (Invention II) corresponds to embodiments of the same server described in the specification (e.g. server 102 in FIGs. 1A, 1B, 2, 7A, 7B, 8A and 8B), not separate subcombinations. Therefore, the Examiner’s characterization of claims 1 and 12 being limited to separate subcombinations disclosed in the specification as usable together in a single combination is inaccurate. Accordingly, the Examiner’s rationale for requiring restriction is flawed.

Furthermore, according to M.P.E.P. 806.05(d) subcombinations are usually restrictable when the subcombinations do not overlap in scope and are not obvious

variants. Applicants do not contend that Inventions I and II are obvious variations. However, since both Invention I and Invention II include a similar server, there is an overlap in scope between Inventions I and Invention II. Thus, Inventions I and II are not separate restrictable subcombinations according to M.P.E.P. 806.05(d). For example, an entity could provide a server that met the limitations of the server of claim 1 (Invention I) and the server of claim 12 (Invention II) and use that server with a small device as recited in claim 1. Such an entity would infringe both claim 1 (Invention I) and claim 12 (Invention II). Since there is some overlap between Invention I and Invention II, according to M.P.E.P. 806.05(d) restriction cannot be required as subcombinations useable together in a disclosed combination. Thus, the Examiner clearly has not stated a proper restriction requirement.

Furthermore, to state a proper restriction requirement for subcombinations usable together in a single combination, the Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. The burden is on the Examiner to provide a proper example. M.P.E.P. 806.05(d). The example given by the Examiner is that “invention I has separate utility such as drawn to a system, method, and article of manufacture comprising a server comprising a document in a format supported by the server, wherein the document is available to one or more devices via a network; a small device configured to couple to the server,...etc (as set forth in invention II).” The Examiner has merely repeated her definition of Invention I, not provided an example of a utility for one of the subcombinations other than in the disclosed combination. In fact, in stating a separate utility for Invention I, the Examiner concludes by stating “as set forth in invention II”. Thus, on its face, the example of a utility set forth by the Examiner would seem to apply to both Invention I and Invention II. Applicant is not asserting that a separate utility is not possible; however, the Examiner has clearly failed to provide an example of a separate utility as required by M.P.E.P. 806.05(d). The “burden is on the Examiner to provide a proper example” of such utility. M.P.E.P. 806.05(d). The Examiner has clearly not met this burden. Thus, the restriction requirement is improper.

The Examiner has failed to state a proper restriction requirement as noted above. As such, Applicants respectfully request the removal of the restriction requirement and request examination of all pending claims.

CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant(s) hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10500/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,



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